Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte GREGORY W. HAGGQUIST,
RONALD H. LEVIN, and
SCOTT T. MOSIER

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Appeal No. 2001-0389
Application No. 09/237,880

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ON BRIEF

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Before KIMLIN, OWENS, and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 26, 29, and 30, which are the remaining claims in the application.

The subject matter on appeal is represented by claim 1, set forth below:

1. A charge transport layer, comprising a hydrazone charge transport compound, C.I. Solvent Yellow 138 and an ester-containing antioxidant.

Claims 1 through 26, 29, and 30 stand rejected under 35 U.S.C. § 112, second paragraph (indefiniteness).

On page 6 of the brief, appellants state that claims 1 through 26, 29, and 30 stand or fall together. Hence, we consider claim 1 in this appeal. 37 CFR § 1.192(c)(7)(8) (2000).

Opinion

The examiner states that the claims are indefinite because of the recitation "C.I. Solvent Yellow 138." The examiner states that one of ordinary skill in the art would not know the compound represented by C.I. Solvent Yellow 138.

The examiner states that C.I. Solvent Yellow 138 does not identify the dye rather it only identifies the source of the dye, much like a trademark would function. (answer, pages 2 through 3).

On page 8 of the brief, appellants submit that C.I. Solvent Yellow 138 is definite to one skilled in the art, and that C.I. Solvent Yellow 138 identifies a dye, and not the source of a dye.

Appellants state that "C.I." is an abbreviation for Colour Index. Appellants state that, as is known in the art, the Colour Index is published by the Society of Dyers and Colourists and the American Association of Textile Chemists and Colorists and is the definitive guide for commercially available dyes and pigments and their technical properties. (brief, page 8). Appellants state that contrary to the examiner's assertion, a C.I. designation is not a

trademark which identifies a source, but rather is a generic designation of a particular dye.[1] (brief, page 9). Appellants refer to copies of pages from Volume 7 of the Colour Index I for support thereof.

Appellants also refer to several U.S. patents and state that these patents recite claim limitations such as "C.I. Solvent Yellow 162", without disclosing the corresponding chemical formula. (brief, page 9).

Appellants conclude that the phrase "C.I. Solvent Yellow 138" allows one of ordinary skill in the art to regularly and actively determine the boundaries of protection of the present invention.

On page 3 of the answer, the examiner rebuts and states that there is no documentation of record that the particularly claimed C.I. Solvent Yellow 138 has a specified chemical formula that is not subject to change. The examiner states that C.I. Solvent Yellow 138 is proprietary and the structure is unknown to one of ordinary skill in the art.

In the reply brief, appellants state that the very fact that a C.I. designation exists establishes that it has known, specific characteristics. (reply brief, page 1).

Our analysis is set forth below.

[1] We note that this is an incorrect interpretation of the examiner's position. The examiner states that the phrase does not identify the dye, but rather it only identifies the source of the dye, much like a trademark would function. (Paper No. 7, page 3). The examiner does not state that the phrase "C.I. Solvent Yellow" is a trademark.

The examiner bears the initial burden of presenting a prima facie case of unpatentability, whether the rejection is based on prior art or any other ground. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The requirement under 35 U.S.C. §112, second paragraph, is only that the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity. In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971). The definiteness of the language employed in the claims must be analyzed, not in a vacuum, but always in light of the teachings of the prior art and the application disclosure as it would be interpreted by one of ordinary skill in the art. See In re Angstadt, 537 F.2d 498, 501, 190 USPQ 214, 217 (CCPA 1976).

Appellants explain that the Colour Index is a known publication, published by the Society of Dyers and Colourists and the American Association of Textile Chemists and Colorists, and is the definitive guide for commercially available dyes and pigments and their technical properties. (brief, page 8). Appellants' position is that, therefore, "C.I. Solvent Yellow 138" is easily identifiable by using this publication.

We determine that the examiner has not convincingly explained why the skilled artisan would not be reasonably apprised of the claim scope when the Colour Index identifies the dye. It appears that the examiner believes that the chemical formula of the dye could be subject to change and therefore, in this way, the claim is indefinite. (answer, page 3). Yet, the examiner has not established that one of ordinary skill in the art would not understand, with respect to definiteness, what specific color corresponds to C.I.

Solvent Yellow 138. It is the examiner's burden to do so in order to establish a prima facie case of indefiniteness under 35 U.S.C. §112, second paragraph.

To the extent the examiner's rejection is based on 35 U.S.C. § 112, first paragraph, appellants have identified two manufacturers on page 8 of the specification. Also, as recognized by the examiner on page 2 of Paper No. 7, appellants provided documents indicating that Sandoz Chemicals and Boulder Scientific Company are suppliers of C.I. Solvent Yellow 138. These documents provide information about the dye, including its chemical family, "styryl dye", pH, solubility, odor, and color. Should these companies stop making the product, the examiner has not demonstrated that one of ordinary skill in the art, armed with this information, would not be able to formulate a composition that correlates to the color of C.I. Solvent Yellow 138. Moreover, "the probability of all these manufacturers choosing to cease manufacture or to change the composition of their respective products is far less than the probability of any one of them choosing to do so". In re Metcalfe, 410 F.2d 1378, 1382, 161 USPQ 789, 792-793 (CCPA 1969).

In view of the above, we determine that the examiner has not met his burden of establishing a prima facie case.

We therefore reverse.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

EDWARD C. KIMLIN Administrative Patent Judge	)
TERRY J. OWENS Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
BEVERLY A. PAWLIKOWSKI Administrative Patent Judge	)

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